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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,652	10/30/2003	Vincent Cedric Colnot		7794
24739	7590	04/02/2007	EXAMINER	
CENTRAL COAST PATENT AGENCY, INC 3 HANGAR WAY SUITE D WATSONVILLE, CA 95076			GEE, JASON KAI YIN	
		ART UNIT	PAPER NUMBER	
		2134		
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/02/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/696,652	COLNOT, VINCENT CEDRIC
	Examiner Jason K. Gee	Art Unit 2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 October 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

1. This action is response to communication: application filed on 10/30/2003 with acknowledgement of benefit date of 11/04/2002.
2. Claims 1-13 are currently pending in this application. Claim 1 is an independent claim.
3. No IDS was received for this application.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 1-13, the applicants claim both a method and an apparatus.

Claiming both a method and an apparatus is directed to neither a "process" nor a "machine", but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.

Also, as per claims 1-13, the applicants recite the absence of processing means within the card reader. Without any processing means, a card reader would be rendered useless, as it cannot read a smart card. This invention would then have no useful result.

Further, as per claims 1-13, the claims do not yield a tangible result. The claim consists of only hardware, and an action of demodulating a signal, which does not yield a tangible result.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-13 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claims 1-13, the applicants recite in the independent claim that processing means is absent from the card reader. It is not enabled how a card reader will be able to read a card without processing it.

As per claims 4-13, the method claims wherein the session key is a function of the 'previous one'. If this 'one' was directed toward a key, it is not enabled how the system would work for the first time. For the first time use, there would be no previous key, and the system would not be able to operate.

Also, as per claims 2-13, the claims recite a random number valid only once. As seen in the specification, it would seem that each time a card is used, a random number must be emitted by a card. It is not enabled by the specification how the smart card

itself may generate a random number each time it is used, as there are no details describing the generation of a different random number each time.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1-13, the claims recite both an apparatus and a method. A single claim which claims both an apparatus and method steps of using the apparatus is indefinite under 35 U.S.C 112, second paragraph. *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). See MPEP 2173.05(p).

As per claims 1-13, the claims recite an IVR applet..., and characterized by the absence ...". It is unclear what part of the invention is being characterized (an applet, the system, etc).

As per claims 2-7, claim 2 recites "and valid only once." It is unclear whether the random number, or both the random number and the unique card number is valid only once.

As per claims 3-7, the claims recite "the authentication server." There is insufficient antecedent basis for this term.

As per claims 4-7, the claims recite "is a function of the previous one." It is unclear what "the previous one" is, and there is insufficient antecedent basis for this term in the claims.

As per claims 4-7, the claims recite the term "such as." It is unclear what the intended metes and bounds are of the claim, and is therefore indefinite.

As per claims 5-7, the claims recite "said encryption code." There is insufficient antecedent basis for this limitation in the claim.

As per claims 6-7, the claims recite "the authentication server database." There is insufficient antecedent basis for this limitation in the claims.

As per claims 6-7, the claims recite "using a session key deduced from the previous one." It is unclear whether this session key refers to the same session key as the ones cited in the previous claims.

As per claims 9-12, the claim recites "wherein the smart card transmits the modulated signal when the switch of the card reader is pressed by the user." This claim is contradictory to the parent claim, as it is recited that processing means are absent within the card reader.

As per claims 9-12, the claims recite "the switch of the card reader." There is insufficient antecedent basis for this limitation in the claim.

As per claims 9-12, the claims recite "the user." There is insufficient antecedent basis for this limitation in the claim.

As per claims 10-12, the claims recite "ISO contact C6." It is unclear what C6 is, and there is insufficient antecedent basis for this limitation in the claim.

As per claims 11-12, the claims recite "ISO contact C2." It is unclear what C2 is, and how a contact is pulled down. There is also insufficient antecedent basis for the term "C2" in the claim.

As per claim 12, the claims recite "the ISO contacts C4 and C8." It is unclear what C4 and C8 are, and there is insufficient antecedent basis for this limitation in the claims.

As there are multiple 101 and 112 rejections in all the pending claims, the claims will be rejected as best understood by the Examiner in order to expedite a complete examination of the instant application.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landry et al US Patent No. 6,687,350 (hereinafter Landry), in view of Brown et al. US Patent Application Publication 2001/0013001 (hereinafter Brown).

As per claim 1, as best understood by the examiner, Landry teaches a method and apparatus to secure online transaction over the phone comprising: a smart card transmitting a identification sequence to an IRV server in the form of a modulated signal

(col. 10 lines 25-30; col. 5 lines 1-10; col. 6 lines 5-29); a card reader plugged into the telephone line (col. 5 lines 1-10; col. 2 lines 45-65), and characterized by the absence of processing means within the card reader (throughout the reference, as the smart card reader is taught to take input, and the system then processes the information). It is inherent that the signal is demodulated, as a modulated signal must be demodulated in order for the data to be useful and processed.

However, at the time of the invention, Landry does not explicitly teach an IVR applet. Landry teaches the use of IVR application server in col. 5 lines 10-15, which is able to process information. However, applets are well known in the art, as they are just small programs designed to run applications. The use of applets with an IVR is taught throughout Brown, such as in paragraph 69.

At the time of the invention, it would have been obvious to include applets in an IVR system. Applets are well known in the art, and by implement an applet in an IVR system, operations may be performed on servers or clients. This is taught in paragraph 69 of Brown.

As per claim 13, Landry teaches wherein the card reader is further integrated into the telephone handset (col. 2 lines 45-68).

11. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landry and Brown as applied above, and further in view of Chang et al. US Patent No. 6,715,082 (hereinafter Chang).

As per claim 2, Landry teaches a credit card number in col. 1 lines 25-29, which is a unique number. However, Landry and Brown do not explicitly teach the use of one time keys on a smart card. These are well known in the art, as can be seen in Chang col. 2 lines 10-25.

At the time of the invention, it would have been obvious to include random one-time keys to be stored on smart cards. One of ordinary skill in the art would have been motivated to perform such an addition to increase security. This is taught by Chang in col. 2 lines 11-15.

As per claim 3, the one-time password taught by Chang in col. 2 lines 10-25 is a key used in a session. It is taught in Chang that this one time password/key is not transmitted to an authentication server, as it is only transmitted to an access server.

12. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landry, Brown, and Chang as applied above, and further in view of Bruce Schneier's Applied Cryptography, 2nd Edition (1997), (hereinafter Schneier).

As per claims 4-7, as best understood by the Examiner, the claims recite the use of encryption keys, decryption, one-way functions and authentication. These are well known in the art, as taught throughout Schneier, such as in pages 28-42.

At the time of the invention, it would have been obvious to combine the teachings of Schneier with the Landry combination. One of ordinary skill in the art would have been motivated to perform such an addition to be able to provide a secure system. The

Landry combination is already directed to secure online transactions, and Schneier teaches the details of this.

13. Claims 8-12 are rejected under 35 U.S.C 103(a) as being obvious over the Landry combination.

As per claim 8, the claim recites wherein the smart card is powered by the voltage provided by the telephone line. It is well known in the art that telephones are powered by the power flowing from telephone lines. At the time of the invention, It would have been obvious to power a smart card that is connected to a phone using the voltage provided to the phone, as this would reduce the amount of outside power sources.

As per claim 9, the claim recites wherein the smart card transmits a signal when a switch is pressed. It is well known in the art to perform an action by pressing a switch. At the time of the invention, it would have been obvious to one of ordinary skill in the art to transmit a signal when a switch is pressed. One of ordinary skill in the art would have been motivated to perform such an addition to be able to manually control the transmission.

As per claims 10-12, as best understood by the Examiner, it is inherent that contacts must be used to operate the system electronically.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason K. Gee whose telephone number is (571) 272-6431. The examiner can normally be reached on M-F, 7:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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03/28/2007


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